UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,920	03/30/2001	Samuel Daniel Dull III	ROC920010099US1	7671

7590 11/30/2005	EXAMINER
Grant A. Johnson	FOWLKES, ANDRE R
IBM Corporation, Dept. 917	

ART UNIT	PAPER NUMBER
2192	

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DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/821,920	DULL ET AL.
	Examiner	Art Unit	
	Andre R. Fowlkes	2192	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>25 July 2005</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-5 and 7-26</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-5 and 7-26</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This action is in response to the amendment filed 7/25/05.

2.   Claims 1-2, 9-10, 12, 15-20 and 22-23 have been amended. Claim 6 has been

canceled. Claim 26 has been added.

Claim Objections

3.   The objection to the claims in accordance with 37 CFR 1.126, is withdrawn, in

view of applicant's amendment.

Claim Rejections - 35 USC § 112

4.   The rejection of claims 20 and 22 under 35 USC 112 is withdrawn, in view of

applicant's amendment.

Claim Rejections - 35 USC § 101

5.   The rejection of claim 17 under 35 U.S.C. 101 is withdrawn, in view of applicant's

amendment.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public
use or on sale in this country, more than one year prior to the date of application for patent in the United
States.

7.   Claims 1-5 and 7-26 are rejected under 35 U.S.C. 102(b) as being anticipated by

London Shrader et al., (Shrader), U.S. Patent No. 5,870,611.

As per claim 1, Shrader discloses **a method of upgrading a computer program**

on a computer system, the computer program including an instruction

processing module, (col. 1:18-21, " This invention relates generally to electronic

distribution of software in computer networks. More particularly, the invention relates to

defining and constructing a proposed plan object for installing the software on the

network"), **the method comprising:**

        - receiving an upgrade object associated with the computer program (col.

1:20-21, " the invention relates to defining and constructing a proposed plan object (i.e.

upgrade object) for installing the software on the network""),

        - the upgrade object including an instruction set adapted for use by the

instruction processing module to upgrade the computer program (col. 4:17-18, "

The RAM 24 is the main memory into which the operating system (i.e. instruction

processing program) and application programs (i.e. upgrade object) are loaded", and

col. 4:36-37, "One of the preferred implementations of the invention (i.e. the upgrade

object) is as sets of instructions resident on the random access memory"),

        - and executing the instruction set with the instruction processing module

(col. 4:17-18, " The RAM 24 is the main memory into which the operating system (i.e.

instruction processing program) and application programs (i.e. instruction sets) are

loaded", and col. 4:36-37, "One of the preferred implementation s of the invention is as

sets of instructions resident on the random access memory").

As per claim 2, the rejection of claim 1 is incorporated and further, Shrader

discloses **instructing the instruction processing module to execute the instruction**

set (col. 4:17-18, " The RAM 24 is the main memory into which the operating system

(i.e. instruction processing program) and application programs (i.e. instruction sets) are

loaded", and col. 4:36-37, "One of the preferred implementation s of the invention is as

sets of instructions resident on the random access memory").

As per claim 3, the rejection of claim 1 is incorporated and further, Shrader

discloses that **the upgrade object is associated with one or more prerequisites;**

and further comprising determining if the one or more prerequisites have been

met (col. 5:60-62, "An important aspect of the invention is that the install plan object (i.e.

upgrade object) and its subcomponents are implemented in an object oriented system",

and col. 5:34-39, "An LCU command file (i.e. an upgrade object attribute) identifies ...

the order in which the products should be installed or configured (i.e. prerequisites)").

As per claim 4, the rejection of claim 1 is incorporated and further, Shrader

discloses **reporting that the instruction set has been executed** (col. 6:60-62, "The

network information tool 66 is used to determine (and report) the status of a committed

plan object (i.e. installation/upgrade instruction sets)").

As per claim 5, the rejection of claim 1 is incorporated and further, Shrader discloses that **the upgrade object is suitable for transmission by electronic mail** (col. 5:22-25, "one or more machines in the network as a code server from which other workstations in the network receive the computer software").

Claim 6 has been canceled.

As per claim 7, the rejection of claim 1 is incorporated and further, Shrader discloses that **the instruction set comprises binary instructions** (col. 9:20, " Install Scripts (i.e. binary instructions)").

As per claim 8, the rejection of claim 1 is incorporated and further, Shrader discloses that **the instruction set comprises a script** (col. 9:20, " Install Scripts").

As per claim 9, the rejection of claim 8 is incorporated and further, Shrader discloses that **the instruction processing module is adapted to compile and execute the script** (col. 9:20, " Install Scripts (are executed)").

As per claim 10, the rejection of claim 1 is incorporated and further, Shrader discloses that **the upgrade object requires the instruction processing module to be executed by the computer system** (col. 9:57-10:5, "The code server container object

(i.e. instruction processing program) may contain one or more code server objects 350.

FIG. 6 depicts the code server container object 62 with a code server object 350 and an

application image object 400. The code server object represents a physical file server

machine which store the application images and which is to be accessed by client

workstations during an installation, configuration, reinstall or removal of application

software. The code server also contains directories to the various command and

response files needed to perform the remote installation. The Code Server object 350

encapsulates the data and methods needed to discover where installable code images

are located and to build network file system attach commands for those code images

(i.e. upgrade object). It can also be used to store generated response files and output

log files. It is a container for application images").

As per claim 11, the rejection of claim 1 is incorporated and further, Shrader

discloses that **the upgrade object is not independently executable** (col. 9:57-10:5,

"The code server container object (i.e. instruction processing program) may contain one

or more code server objects ... The Code Server object 350 encapsulates (i.e. is

needed to execute) the data and methods needed to discover where installable code

images are located and to build network file system attach commands for those code

images (i.e. upgrade object). It can also be used to store generated response files and

output log files. It is a container for application images").

As per claims 12-15, this is another method version of the claimed method discussed above, in claims 2, 4, 9 and 11, wherein all claimed limitations have also been addressed and/or cited as set forth above. The instruction processing program of claim 1 is identical to the script processor of claim 12. For example, see Shrader's install plan object for network installation of application programs (col. 1:18-9:65).

As per claim 16, this is another method version of the claimed method discussed above, in claims 3, 4 and 9, wherein all claimed limitations have also been addressed and/or cited as set forth above. For example, see Shrader's install plan object for network installation of application programs (col. 1:18-9:65).

As per claim 17, this is a product version of the claimed method discussed above, in claim 1, wherein all claimed limitations have also been addressed and/or cited as set forth above. For example, see Shrader's install plan object for network installation of application programs (col. 1:18-9:65).

As per claims 18-22, this is another method version of the claimed method discussed above, in claims 3-5, wherein all claimed limitations have also been addressed and/or cited as set forth above. For example, see Shrader's install plan object for network installation of application programs (col. 1:18-9:65).

As per claims 23-26, these are other method versions of the claimed method

discussed above, in claims 4, 5 and 11, wherein all claimed limitations have also been

addressed and/or cited as set forth above. For example, see Shrader's install plan

object for network installation of application programs (col. 1:18-9:65).

Response to Arguments

9.   Applicants arguments have been considered but they are not persuasive.

In the remarks, the applicant has argued substantially that:

1)   Shrader does not disclose creating/receiving an upgrade object associated with

the computer program, the upgrade object including a script/instruction set adapted for

use by the instruction/script processing module to upgrade the computer program with

respect to claims 1, 12, 16-18 & 23, at p. 13:20-14:17.

Examiner's response:

1)   The examiner disagrees with applicant's characterization of the applied art.

Shrader does disclose creating/receiving an upgrade object associated with the

computer program, the upgrade object including a script/instruction set adapted for use

by the instruction/script processing module to upgrade the computer program, at col.

1:18-21, " This invention relates generally to electronic distribution of software in

computer networks. More particularly, the invention relates to <u>defining and constructing</u>

<u>a proposed plan object for installing the software on the network</u>" and col. 4:17-18, " The

RAM 24 is the main memory into which the operating system (i.e. instruction processing

program) and <u>application programs (i.e. upgrade object) are loaded</u>", as addressed in

the above art rejection.

In the remarks, the applicant has argued substantially that:

2)   The present invention is distinguished over Shrader because the present

invention allows an application to install and/or update itself, at p. 13:14-16.

Examiner's response:

2)   In response to applicant's argument that the references fail to show certain

features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., the applicant's invention allows the application to update itself) are not recited in

the rejected claim(s). Although the claims are interpreted in light of the specification,

limitations from the specification are not read into the claims. See *In re Van Geuns*, 988

F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In the remarks, the applicant has argued substantially that:

3)   Shrader does not disclose that the upgrade object includes a prerequisite field

containing one or more prerequisites, at p. 14:3-5.

Examiner's response:

3)   The examiner disagrees with applicant's characterization of the applied art.

Shrader does disclose that the upgrade object includes a prerequisite field containing

one or more prerequisites, at col. 5:60-62, "An important aspect of the invention is that

the install plan object (i.e. upgrade object) and its subcomponents are implemented in

an object oriented system", and col. 5:34-39, "An LCU command file (i.e. an upgrade

object attribute) identifies ... the order in which the products should be installed or

configured (i.e. prerequisites)", as addressed in the above art rejection.

Conclusion

10.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37
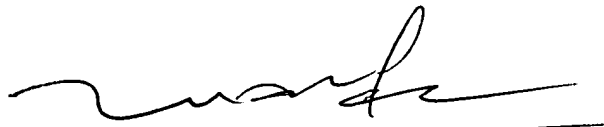
CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Andre R. Fowlkes whose telephone number is (571)

272-3697. The examiner can normally be reached on Monday - Friday, 8:00am-

4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tuan Q. Dam can be reached on (571)272-3695. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

ARF

TUAN DAM
SUPERVISORY PATENT EXAMINER